

REMARKS

I. Status of Claims

Claims 1-40, 161, and 162 are pending in this application. Claims 41-120, 152-155, and 163 have been withdrawn from consideration. Claims 1 and 161 have been amended.

II. Rejection under 35 U.S.C. § 102

Claims 1-2, 5, 10, 11, 25, 27-30, 37-39, and 161 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,660,838 ("Koga"). *Office Action* at p. 3. Applicants respectfully traverse this rejection in light of the amendments and following remarks.

Applicants have amended the specification to add the film formers listed the CTFA International Cosmetic Ingredient Dictionary pages referenced in the specification at the paragraph bridging pages 10 and 11. Thus, the paragraph bridging pages 10 and 11 has been deleted and replaced with three new paragraphs. The first new paragraph is the exact same passage formerly at p. 10, line 18 to page 11, line 1. The second paragraph is the listing of film forming agents from pages 1744 to 1747 of the CTFA International Cosmetic Ingredient Dictionary, 8th edition (2000). The third new paragraph is the exact same passage formerly at page 11, lines 1-10.

Applicants also submit a declaration herewith stating that the amended material consists of the same material incorporated by reference. M.P.E.P. § 608.01(p).I.A.2.

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Applicants believe that no new matter has been added and that the filing date of the application is not affected. *Id.*

Applicants have also amended pending independent claims 1 and 161 to add "with the proviso that the at least one film forming agent is not hydroxypropylmethylcellulose." Applicants believe that adding this proviso is fully supported by the specification as filed. By excluding hydroxypropylmethylcellulose from the scope of the claims, Applicants are simply claiming less than the full scope of their disclosure – a legitimate procedure for inventors entitled to decide the bounds of protection they seek. Applicants respectfully submit that *In re Johnson*, 558 F.2d 1008 (C.C.P.A. 1977) provides legal precedent for amendment of this proviso. *Johnson* provides that a "broad and complete generic disclosure, coupled with extensive examples fully supportive of the limited genus now claimed" supports the exclusion of specific compounds. *Id.* at 1018. In *Johnson*, a broad class of precursor compounds was recited including 26 specific examples. An added proviso excluded certain compounds to provide a limited genus, where 14 examples fell within the scope of the limited genus. The court in *Johnson* held that the written description supported the broader genus, and "having described the whole, necessarily described the part remaining." *Id.* at 1019.

Applicants respectfully submit that the subgenus of film forming agents excluding hydroxypropylmethylcellulose was disclosed in the present specification as filed. As stated above, the specification as filed lists a source of exemplary film forming agents. This list has been added by the amendment to the specification. Thus, the specification

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provides written description support for film forming agents excluding "hydroxypropylmethylcellulose." As in *Johnson*, this fact provides sufficient evidence that Applicants considered the subject matter of the presently claimed invention to be within the scope of their invention, and the amended proviso is not new matter for this reason.

Koga discloses xylobiose-containing skin preparations and shampoos for external use. See *Koga Abstract*. In Example 7, Koga describes a hair shampoo containing hydroxymethylpropyl cellulose. *Id.* at col. 10. Koga, however, teaches that hydroxymethylpropyl cellulose is useful as a mucilage, e.g., a thickener. Thus, because Koga does not teach using hydroxymethylpropyl cellulose as a film forming agent, Koga does not anticipate the present claims. Nonetheless, to expedite prosecution, Applicants have amended independent claims 1 and 161 as described above.

Accordingly, Applicants respectfully request withdrawal of this rejection.

III. Rejections under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness, there must be some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to modify or combine reference teachings with a reasonable expectation of success in obtaining the presently claimed invention. M.P.E.P. § 2143.01; 2143.02.

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Beck

Claims 1-4, 10-40, 161, and 162 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. 2002/0031483 ("Beck"). *Office Action* at pp. 3-5.

Applicants respectfully traverse this rejection.

The Examiner supports the rejection by noting that Beck teaches a hair treatment composition comprising sugars such as trioses, tetroses, and pentoses, and film-forming cationic polymers. *Id.* at pp. 3-4.

Applicants respectfully disagree that Beck teaches or suggests the claimed invention. Evidence of a suggestion or motivation to modify or combine must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Beck, in contrast, discloses the claimed limitations only in isolated passages throughout the specification. Beck teaches the use of sugars from trioses to hexoses without suggesting the desirability of compounds chosen from C₃-C₅ saccharides compared to C₆ saccharides, as required in M.P.E.P. § 2143.01. ("The prior art must suggest the desirability of the claimed invention.").

Moreover, Beck is directed to a composition comprising "a polymeric cationic conditioning compound that is substantive to the hair and imparts conditioning properties." *Beck* at para. 0039. There is no suggestion in Beck that these polymeric cationic compounds must be a film forming agent, much less that the composition comprises a film forming agent and at least one compound chosen from C₃-C₅ saccharides. To arrive at the claimed invention from Beck, one of ordinary skill in the art must pick from a myriad of possibilities without specific guidance to arrive at the

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claimed invention. Thus, Applicants respectfully submit that Beck's lack of specific guidance does not comply with the "clear and particular" standard articulated in *Dembiczak*. See also *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). ("The need for specificity pervades this authority").

Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of this rejection.

Keil and Beck

Claims 1-40, 161, and 162 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,690,924 ("Keil") in view of U.S. Pub. No. 2002/0031483 ("Beck"). *Office Action* at pp. 5-5. Applicants respectfully traverse this rejection.

The Examiner states that Keil teaches hair treatment compositions "but does not teach the instant monosaccharides." *Id.* at p. 5. Thus, the Examiner relies on Beck for teaching trioses, tetroses, and pentoses and film-forming cationic polymers. *Id.*

Applicants respectfully disagree that the references can be so combined. Keil describes the benefits of a chitosan-containing composition. *Keil* at col. 1, line 56 to col. 2, line 7. Keil accentuates the importance of chitosan by noting that care properties of the composition were improved over compositions "without the simultaneous presence of the high molecular weight chitosonium-pyrrolidone carboxylate." *Id.* at col. 2, lines 1-7. Thus, one of ordinary skill in the art appreciating the benefits of chitosan advocated by Keil would not find it obvious to replace the chitosan with the sugars of Beck.

Moreover, by specifically teaching the use of chitosan, Keil teaches away from Beck's composition.

Because there is no suggestion to combine the references, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of this rejection.

IV. Conclusion

Applicants respectfully request the reconsideration and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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